UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/024,799	12/19/2001	Mark Douglas Freeman	56145473-15	6081

26453 7590 02/22/2007

BAKER & MCKENZIE LLP
1114 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

EXAMINER	
KOHUT, DAVID M	
ART UNIT	**PAPER NUMBER**
3626	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/22/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/024,799	FREEMAN ET AL.	
	Examiner	Art Unit	
	David M. Kohut	3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-21 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-21 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on 14 December 2001 is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date 27 December 2002.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The use of the trademarks "Web Trends" and "Central Ad" has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

2. The disclosure is objected to because of the following informalities:

a. Page 5, line 21, change "database" to "databases";

b. Page 6, line 2, Examiner, through interpretation of the specification, believes that reference character "220" should actually be reference character "120".

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-6, 10-11, and 13-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Davis et al., U.S. Patent No. 5,796,952, reference A in the attached PTO-892.

5. As per claim 1, Davis et al. teaches a method for tracking user activity, comprising: identifying the user accessing a first web page, i.e. when a web browser makes a request for information from a server it typically includes certain information about the client in the "HTTP request header" (see column 10, lines 62-65 of Davis et al.); determining that an impression associated with the first web page was selected by the user after the user has been identified, the impression having a unique identification associated with the impression and being one of a plurality of impressions for directing the user to a second web page, i.e. this HTML document contains text, as well as embedded URLs that point to graphical images which are embedded inside the Web page using the known HTML <IMG> tag, which allows one to specify the source URL for an image, as well as additional information such as size and other layout parameters (see column 11, lines 37-39 and 41-45 of Davis et al.); transmitting at least the unique identification of the selected impression to a website associated with the second web page upon the user selecting the impression, i.e. this second CGI script can then obtain any information tracked and transmitted by the applet as well as any available information in the HTTP request header and store it in a database on Server B or elsewhere (see column 12, lines 36-40 of Davis et al.); receiving from the website data indicating that the user successfully performed at least one predetermined task and the unique identification, i.e. when the user performs another predetermined action, the tracking program calculates the amount of time between the predetermined user actions, and sends this information, along with other available client information, to the server (see column 13, lines 42-45 of Davis et al.); storing the received data in a

memory unit, i.e. this information is sorted and stored in the server database and may be analyzed manually or automatically (see column 14, lines 44-46 of Davis et al.).

6. As per claim 2, Davis et al. teaches the method of claim 1 as described above. Davis et al. further teaches the method wherein a plurality of links are located on the first web page, i.e. this HTML document contains text, as well as embedded URLs that point to graphical images also located on the first server A (see column 11, lines 37-40 of Davis et al.).

7. As per claim 3, Davis et al. teaches the method of claim 1 as described above. Davis et al. further teaches the method wherein the at least one predetermined task is a purchase, i.e. the tracking program may monitor the user's interaction with the Web page and the ad banner, such as by monitoring each of the choices made by the user within the Web page and ad banner that may include the means by which to order or purchase specific goods and services (see column 14, lines 15-16, 24-25, and 27-30 of Davis et al.).

8. As per claim 4, Davis et al. teaches the method of claim 1 as described above. Davis et al. further teaches the method wherein the at least one predetermined task is a sign-up, i.e. the client profile is created by the client through the use of HTML "fill-in" form tags (see column 18, lines 40-42 of Davis et al.).

9. As per claim 5, Davis et al. teaches the method of claim 1 as described above. Davis et al. further teaches the method wherein the at least one predetermined task is a click thru, i.e. the tracking program also determines the current time upon the

performance of a predetermined operation on the client computer by a user, such as leaving the HTML document (see column 5, lines 48-51 of Davis et al.).

10. As per claim 6, Davis et al. teaches the method of claim 1 as described above. Davis et al. further teaches the method wherein the unique identification is a string of characters, i.e. the information stored in the server database may include the network ID, client ID, the associated link (the URL of the web page), the amount of time the user spent interacting with the Web page, and any selections or choices made by the user while interacting with the Web page (see column 11, lines 20-24 of Davis et al.).

11. As per claim 10, Davis et al. teaches a method for tracking user activity, comprising: associating a user accessing a first user interface page with a user identifier, i.e. in attempting to render the Web page, the client will automatically fetch the resource on Server B, which will result in execution of a CGI script 1 which can capture client information such as Network ID or Client ID and returns a transparent image (see column 16, lines 29-33 of Davis et al.); the user interface page having one or more advertisement links to one or more second user interface pages, i.e. this HTML document contains text, as well as embedded URLs that point to graphical images which are embedded inside the Web page using the known HTML <IMG> tag, which allows one to specify the source URL for an image, as well as additional information such as size and other layout parameters (see column 11, lines 37-39 and 41-45 of Davis et al.); identifying an advertisement link selected by the user among the one or more advertisement links, the advertisement link for directing the user to a second user interface page, i.e. the ad banner itself may have an embedded address referring to yet

another Web resource and when the user "clicks" on the ad banner, the client may load a resource on the second server which once again captures the user's ID and forwards the user to a Web resource which is appropriate for the displayed ad (for example, a page on the advertiser's Web site)(see column 3, lines 44-50 of Davis et al.); associating the advertisement link with a link identifier, i.e. the ad banner itself may have an embedded address referring to yet another Web resource (see column 3, lines 44-46 of Davis et al.); transmitting the user identifier and the link identifier to a server serving the second user interface page, i.e. , the client may load a resource on the second server which once again captures the user's ID and forwards the user to a Web resource which is appropriate for the displayed ad (for example, a page on the advertiser's Web site)(see column 3, lines 47-50 of Davis et al.); receiving from the server the user identifier, the link identifier, and data associated with user's activity on the second user interface page, the data used to track on-line activity of the user, i.e. the tracking program stores client-identifying indicia, such as a user's network ID and client ID numbers, and associated tracking information and may monitor the amount of time the user spends displaying both the Web page and the ad banner embedded in the Web page as a whole, and the user's interaction with the Web page and the ad banner, such as by monitoring each of the choices made by the user within the Web page and ad banner and the information is sorted and stored in the server database (see column 11, lines 13-16 and column 14, lines 24-30 and 41-46 of Davis et al.).

12. As per claim 11, Davis et al. teaches the method of claim 10 as described above. Davis et al. further teaches the method further including: storing the user identifier, the

link identifier, and the data, i.e. in order to store client-identifying indicia, such as a user's network ID and client ID numbers and associated tracking information, a database is set up on the server (see column 11, lines 13-16 of Davis et al.).

13. As per claim 13, Davis et al. teaches the method of claim 10 as described above. Davis et al. further teaches the method wherein the first user interface includes a web page, i.e. a Web page is requested by the client from a first server A (see column 11, lines 35-36 of Davis et al.).

14. As per claim 14, Davis et al. teaches the method of claim 10 as described above. Davis et al. further teaches the method wherein the second user interface includes a web page, i.e. the ad banner itself may have an embedded address referring to yet another Web resource and when the user "clicks" on the ad banner, the client may load a resource on the second server which once again captures the user's ID and forwards the user to a Web resource which is appropriate for the displayed ad (for example, a page on the advertiser's Web site)(see column 3, lines 44-50 of Davis et al.).

15. As per claim 15, Davis et al. teaches the method of claim 10 as described above. Davis et al. further teaches the method wherein the advertisement link includes an impression, i.e. the ad banner itself may have an embedded address referring to yet another Web resource and when the user "clicks" on the ad banner, the client may load a resource on the second server which once again captures the user's ID and forwards the user to a Web resource which is appropriate for the displayed ad (for example, a page on the advertiser's Web site)(see column 3, lines 44-50 of Davis et al.).

16. As per claim 16, Davis et al. teaches the method of claim 10 as described above. Davis et al. further teaches the method wherein the link identifier includes an impression identifier, i.e. the ad banner itself may have an embedded address referring to yet another Web resource and when the user "clicks" on the ad banner, the client may load a resource on the second server which once again captures the user's ID and forwards the user to a Web resource which is appropriate for the displayed ad (for example, a page on the advertiser's Web site)(see column 3, lines 44-50 of Davis et al.).

17. As per claim 17, Davis et al. teaches a tracking system, comprising: a first processing unit for identifying the user accessing a first web page having an impression, i.e. in attempting to render the Web page, the client will automatically fetch the resources on Server B, which will result in execution of a CGI script which captures client information such as Network ID or Client ID and returns a transparent image (see column 16, lines 29-33 of Davis et al.); an identification assignment unit for assigning a unique identification to the impression, the impression being one of a plurality of impressions for directing the user to a second web page, i.e. an ad banner is embedded inside a Web page located on a first server through the use of the known HTML <IMG> tag which is used to reference a resource stored on the same or a different server (see column 3, lines 38-40 of Davis et al.); and a tracking unit for determining that an impression associated with the first web page was selected by the user, i.e. if the user "clicks" on the ad banner, the client may load a resource on the second server which once again captures the user's ID and forwards the user to a Web resource which is appropriate for the displayed ad (see column 3, liens 46-50 of Davis et al.); the tracking

unit transmitting at least the unique identification of the selected impression to a web site associated with the second web page in response to the user selecting the impression, i.e. the tracking program monitors which of the various links are selected and provides this information to the server (see column 14, lines 41-43 of Davis et al.); the tracking unit further receiving data indicating that the user successfully performed at least one predetermined task and the unique identification, i.e. when the user performs another predetermined action, the tracking program calculates the amount of time between the predetermined user actions, and sends this information, along with other available client information to the server (see column 13, lines 41-45 of Davis et al.).

18. As per claim 18, Davis et al. teaches the system of claim 17 as described above. Davis et al. further teaches the system further including a memory unit for storing the received data in at least one database table, i.e. this information is sorted and stored in the server database and may be analyzed manually or automatically (see column 14, lines 44-46 of Davis et al.).

19. As per claim 19, Davis et al. teaches the system of claim 17 as described above. Davis et al. further teaches the system further including: a second processing unit for hosting the web site associated with the second web page, i.e. the ad banner itself may have an embedded address referring to yet another Web resource and if the user "clicks" on the ad banner, the client may load a resource on the second server (see column 3, lines 44-47 of Davis et al.).

20. As per claim 20, Davis et al. teaches the program storage readable by machine, tangibly embodying a program of instructions executable by the machine to perform

method steps of tracking user activity, i.e. the first executable program may also monitor time, keyboard events, mouse events, and the like, in order to track choices and selections made by a user in the file, and may execute upon the occurrence of a predetermined event, as well as monitoring or determining the amount of information downloaded by the client (see abstract, lines 19-25 of Davis et al.); comprising: associating a user accessing a first user interface page with a user identifier, i.e. in attempting to render the Web page, the client will automatically fetch the resource on Server B, which will result in execution of a CGI script 1 which can capture client information such as Network ID or Client ID and returns a transparent image (see column 16, lines 29-33 of Davis et al.); the user interface page having one or more advertisement links to one or more second user interface pages, i.e. this HTML document contains text, as well as embedded URLs that point to graphical images which are embedded inside the Web page using the known HTML <IMG> tag, which allows one to specify the source URL for an image, as well as additional information such as size and other layout parameters (see column 11, lines 37-39 and 41-45 of Davis et al.); identifying an advertisement link selected by the user among the one or more advertisement links, the advertisement link for directing the user to a second user interface page, i.e. the ad banner itself may have an embedded address referring to yet another Web resource and when the user "clicks" on the ad banner, the client may load a resource on the second server which once again captures the user's ID and forwards the user to a Web resource which is appropriate for the displayed ad (for example, a page on the advertiser's Web site)(see column 3, lines 44-50 of Davis et al.);

associating the advertisement link with a link identifier, i.e. the ad banner itself may have an embedded address referring to yet another Web resource (see column 3, lines 44-46 of Davis et al.); transmitting the user identifier and the link identifier to a server serving the second user interface page, i.e. , the client may load a resource on the second server which once again captures the user's ID and forwards the user to a Web resource which is appropriate for the displayed ad (for example, a page on the advertiser's Web site)(see column 3, lines 47-50 of Davis et al.); receiving from the server the user identifier, the link identifier, and data associated with user's activity on the second user interface page, the data used to track on-line activity of the user, i.e. the tracking program stores client-identifying indicia, such as a user's network ID and client ID numbers, and associated tracking information and may monitor the amount of time the user spends displaying both the Web page and the ad banner embedded in the Web page as a whole, and the user's interaction with the Web page and the ad banner, such as by monitoring each of the choices made by the user within the Web page and ad banner and the information is sorted and stored in the server database (see column 11, lines 13-16 and column 14, lines 24-30 and 41-46 of Davis et al.).

21. As per claim 21, Davis et al. teaches the program storage device of claim 10 as described above. Davis et al. further teaches the method wherein the advertisement link includes an impression, i.e. the ad banner itself may have an embedded address referring to yet another Web resource and when the user "clicks" on the ad banner, the client may load a resource on the second server which once again captures the user's ID and forwards the user to a Web resource which is appropriate for the displayed ad

(for example, a page on the advertiser's Web site)(see column 3, lines 44-50 of Davis et al.).

Claim Rejections - 35 USC § 103

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

23. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis et al., U.S. Patent No. 5,796,952, reference A on the attached PTO-892 in view of Klug et al., U.S. Patent No. 5,790,785, reference B on the attached PTO-892.

24. As per claim 7, Davis et al. teaches the method of claim 1 as described above. However, Davis et al. does not explicitly teach requiring the user to input a user name. Klug et al., however, does teach the method wherein identifying the user accessing a first web page includes requiring the user to input a user name, i.e. prior to allowing access to web site services, users are required to register at the web site, wherein the user is required to establish a user identification (user ID) and optionally a password with the web site (see column 1, lines 40-44 of Klug et al.). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine this feature with the teachings of Davis et al. One of ordinary skill in the art would have been motivated to combine this feature so that those responsible for the design and maintenance of the web sites are capable of accurately measuring both the number and types of users accessing their web sites (see column 1, lines 29-33 of Klug et al.).

25. As per claim 8, Davis et al. teaches the method of claim 1 as described above. However, Davis et al. does not explicitly teach a user name and password to access the first web site. Klug et al., however, does teach the method wherein identifying the user accessing a first web page includes requiring the user to input a user name and password, i.e. prior to allowing access to web site services, users are required to register at the web site, wherein the user is required to establish a user identification (user ID) and optionally a password with the web site (see column 1, lines 40-44 of Klug et al.). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine this feature with the teachings of Davis et al. One of ordinary skill in the art would have been motivated to combine this feature so that those responsible for the design and maintenance of the web sites are capable of accurately measuring both the number and types of users accessing their web sites (see column 1, lines 29-33 of Klug et al.).

26. Claims 9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis et al., U.S. Patent No. 5,796,952, reference A on the attached PTO-892, in view of Beck et al., U.S. Patent No. 5,903,723, reference C on the attached PTO-892.

27. As per claim 9, Davis et al. teaches a method of tracking user activity, comprising: transmitting data including an identifier to a web site associated with a web page in response to the user selecting an impression, i.e. this second CGI script can then obtain any information tracked and transmitted by the applet as well as any available information in the HTTP request header and store it in a database on Server B or elsewhere (see column 12, lines 36-40 of Davis et al.); the impression having the

unique identifier and for directing the user to the web page, i.e. this HTML document contains text, as well as embedded URLs that point to graphical images which are embedded inside the Web page using the known HTML <IMG> tag, which allows one to specify the source URL for an image, as well as additional information such as size and other layout parameters (see column 11, lines 37-39 and 41-45 of Davis et al.); receiving from the web site data indicating that the user successfully performed at least one predetermined task and the identifier, i.e. when the user performs another predetermined action, the tracking program calculates the amount of time between the predetermined user actions, and sends this information, along with other available client information, to the server (see column 13, lines 42-45 of Davis et al.); and storing the received data and data identifying the user in a memory unit, i.e. this information is sorted and stored in the server database and may be analyzed manually or automatically (see column 14, lines 44-46 of Davis et al.). However, Davis et al. does not explicitly teach the method wherein the impression is associated with an electronic mail. Beck et al., however, does teach the method wherein the user selects an impression associated with an electronic mail, i.e. the message and URL hypertext link are added to the recipient's mail page and when and if recipient decides to read the attachment, for example by clicking on a hypertext link embedded in message, where the hypertext link incorporates a URL, an attachment is retrieved by recipient, using its server, URL, and Internet (see column 14, lines 10-16 of Beck et al.). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine this feature with the teachings of Davis et al. One of ordinary skill in the art would have

been motivated to combine this feature in order to more efficiently utilize processor and communications medium bandwidth and memory storage in a computer communications network (see column 1, lines 56-58 of Beck et al.).

28. As per claim 12, Davis et al. teaches the method of claim 10 as described above. However, Davis et al. does not explicitly teach the method wherein an electronic mail is the user interface. Beck et al., however, does teach the method wherein the first user interface includes electronic mail, i.e. the message and URL hypertext link are added to the recipient's mail page and when an if recipient decides to read the attachment, for example by clicking on a hypertext link embedded in message, where the hypertext link embedded in the message, where the hypertext link incorporates a URL, attachment is retrieved by recipient using its server, URL, and Internet (see column 14, lines 10-16 of Beck et al.). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine this feature with the teachings of Davis et al. One of ordinary skill in the art would have been motivated to combine this feature in order to more efficiently utilize processor and communications medium bandwidth and memory storage in a computer communications network (see column 1, lines 56-58 of Beck et al.).

Conclusion

1. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David M. Kohut, Esq. whose telephone number is 571-270-1369. The examiner can normally be reached on M-Th 730-5 w/1st Fri off. 2nd Fri 730-4.

2. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick J. Nolan can be reached on 571-272-0847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

3. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DMK

12/06/2006

JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER